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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,781	01/05/2001	Craig S. Skinner	PALM-3551.US.P	3204

7590

06/07/2004

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EXAMINER
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FLEMING, FRITZ M

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/755,781

Applicant(s)

SKINNER, CRAIG S.

Examiner

Fritz M Fleming

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

*Fritz M Fleming*  
FRITZ FLEMING  
PRIMARY EXAMINER  
GROUP 2100

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: Figure 1B uses the reference numeral 100B, but the discussion of 1B only refers to 100, and not 100B. The specification needs to be amended to agree with what is shown. Any other discrepancies found while reviewing the application should also be corrected by applicant.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4,6-11,13-20 rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 862 104 A2 (Moriya et al.—Moriya).

Moriya anticipates the indicated claims, as Moriya teaches an overall automated registration and activation system of Figure 1 comprising the terminals 1, network 3 and server 2. Specifically, the terminal 1 is disclosed to be a PDA (col. 4, line 18), with it insides detailed at Figure 2. Figure 2 shows a PDA with a telephone function, such that the radio communication unit 17 (inherently comprising a transmit and receive unit per col. 5, lines 15-18 to include connection to the network 3) serves as the claimed network interface component. Note also a processor 11 which processes and controls the

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components in terminal 1, inherently to include the automated registration/activation, as this falls under the control of components in the terminal 1. A read only memory is judged to be that of ROM 13 (to store an operation program and the like of terminal 1 per col. 4, lines 33-39) and flash ROM 16 (to store network configuration information like telephone number of terminal 1 and service provided and a password and other information per col. 4, line 47-col. 5, line 14). A data bus is seen at interconnection bus 19.

Applicant has defined "registration and activation of the device on a network" to mean, for example, the establishing of a network account (page 4, lines 4-5). This is exactly what Moriya does per columns 6-11 and Figures 3-11. Of interest, is the first embodiment of columns 6-8 and Figures 5/6. At initial turn on, it is determined if the PDA is registered and activated by the status of the provider registration completion flag (S12), wherein a non registered/activated PDA displays the nonregistration icon 36D (S14) as the provider icon. Provider icon manipulation is awaited (S16), and if such occurs on a non registered/activated PDA (S20 route A), then the automated registration and activation sequence is started (S22+), so as to allow the user to create a network account with a reduction of required entry matters and a facilitation of authentication and connection to the server and network (column 1).

Per claim 2, a network unit identifier is the telephone number and terminal ID and device kind code stored in flash ROM 16. Per claim 3, the processor 11 controls the PDA operations and forwards the flash ROM 16 information to the network 2 and 3 at S36 in response to user manipulation of the icon 36D. Per claim 4, the automatic

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registration and activation is at the behest of the user's manipulation of icon 36D. Per claim 6, the processor controls communications by submitting network configuration information at S36 and receives network unit identification information at S38,40 so that the flag is then set at S42 with additional registration and activation at S44,46. Per claim 7, such is anticipated by the radio communication unit 17 inclusive of the radio public circuit, as a radio public circuit is a cellular communication network, and the transmission and reception of data requires a transmitter and receiver and antenna. Per claim 8, terminal device 1 is a PDA. Claims 9-11,13,14 mirror claims 2-4,6,7 and the same apply. The method steps of claims 15-20 are addressed above, noting also that portions of the network configuration information is loaded by the manufacturer, per the column 4 fixing of the terminal ID at the time of manufacturing.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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6. Claims 5,12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moriya in view of Fingerhut.

Moriya lacks specific mention of automatic registration and activation upon bootup, noting that there is an automatic check of the flag at power up, but automatic registration and activation is at the request of the user.

Fingerhut, in the same field of automated device registration and activation, discloses use in over the air activation of two way wireless communication devices (column 1, lines 7-15), therefore being properly combinable with Moriya. Attention is drawn to column 3, lines 32+ and Figure 2 in which the first step is turn on, with automatic determination of a registered and activated state via UNA status at location 3. If the device is not registered and activated, i.e. no UNA at 3, then the device automatically starts the OAA process.

Therefore it would have been obvious to one having ordinary skill in the art at the time that the invention was made to modify Moriya per the teachings of Fingerhut, so that upon bootup/power up, a non registered/activated device automatically starts the registration and activation process, so as to be automatic, simple, quick, and without human intervention (Fingerhut, column 6, lines 52-63).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rosenberg et al. teach a PALM specific solution. IBM TDB teaches automatic NAM programming. Chatterjee et al. teach automatic OTAF registration. Lipsit teaches automatic wireless registration of PDAs. Lawrence et al.

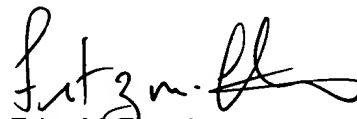
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teach a wireless registration. Gaucher teaches automatic PDA registration. Holmes teaches cellular activation. Findikli et al. teach power up registration. Hsu et al. teach upgrading. Brown et al. teach PDA OTASP. Liao et al. teach provisioning. Moles et al. teach service provisioning. British Telecommunications teach a memory 7. Tiedemann, Jr. et al. teach power up registration.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fritz M Fleming whose telephone number is 703-308-1483. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-1483. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Fritz M Fleming  
Primary Examiner  
Art Unit 2182

fmf